

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	09/738,050
Confirmation No.:	2324
Applicant:	Paul-David Morrison
Filing Date:	December 15, 2000
Art Unit:	2175
Examiner:	Thanh T. Vu
Attorney Docket:	3019-P001US
Customer No.:	75589
Title:	Method and apparatus for an interactive catalog

Commissioner for Patents
P.O. Box 1451
Alexandria, VA 22313-1451

REQUEST FOR REHEARING

Sir:

In response to the Decision on Appeal of June 29, 2010, Appellant requests that the Board rehear Appellant's appeal for the reasons given below.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN THE APPLICATION

There are 36 claims currently pending in the application.

B. STATUS OF ALL CLAIMS

Claims canceled: 4

Claims withdrawn: 24-26 and 32-36

Claims pending: 1-3, 5-23, 27-31, and 37-45

Claims allowed: None

Claims objected to: None

Claims rejected: 1-3, 5-23, 27-31, and 37-45

C. CLAIMS ON APPEAL

Claim 1-3, 5-23, 27-31, and 37-45 are on appeal.

ARGUMENT

In a decision (the “Decision”) dated June 29, 2010, the Board of Patent Appeals and Interferences (the “Board”) affirmed the Examiner’s rejection of all claims in the present patent application. The Board’s Decision indicated that while the reply brief (the “Reply Brief”) of March 10, 2008, was itself timely, its arguments were untimely and were, therefore, not considered by the Board.

Appellant hereby requests reconsideration of the Board’s Decision, wherein arguments presented in the Reply Brief shall also be considered. (The Reply Brief is attached herein as Exhibit AA.)

The issues presented in this Request for Rehearing are as follows:

1. Does the Reply Brief present an untimely argument?
2. Even if the Reply Brief does present an argument that could have been presented in the Appeal Brief, is this permissible in a matter before the Board?
3. Does the Reply Brief make an admission that serves as a waiver of any right to advance the arguments in the Reply Brief?

Issue 1: Does the Reply Brief present an untimely argument?

As stated in Item 1 of the Reply Brief, which concerns claim 1 of the present application, Examiner’s Answer of January 8, 2008, page 14, asserts that Supplemental Appeal Brief (the “Appeal Brief”) of October 15, 2008, attacked the cited references separately. The Examiner failed to raise this issue in the last Office action, dated June 21, 2007, which is the basis for the Appeal Brief. See Office action, June 21, 2007, pages 2-4 (discussing the basis for the rejection of claim 1) and pages 12 and 13 (presenting only an argument regarding motivation to combine references).

Since Examiner’s Answer raised a new issue by arguing that Appellant attacked the cited references separately, Appellant addressed the new issue in the Reply Brief. In both items 1 and 2 of the Reply Brief, Appellant responded to the new issue raised by Examiner’s Answer. Appellant did not raise the issue.

The Decision, pages 9 and 17, cites the informative opinion in *Ex Parte Borden*, 932 USPQ2d 1473, 1475 (BPAI 2010) (informative decision), which states that the reply brief is not

“an opportunity to make arguments that could have been made in the principal brief on appeal to rebut Examiner’s rejections, but were not.” However, in the present case the Reply Brief presents arguments to rebut Examiner’s rejections first raised in the Examiner’s Answer.

It is not untimely for Appellant to address an issue raised by Examiner’s Answer. Indeed, it could be a basis for a decision against Appellant if Appellant failed to submit a Reply Brief to address the issue!

Issue 2: Even if the Reply Brief does present an argument that could have been presented in the Appeal Brief, is this permissible in a matter before the Board?

The Decision, page 9, cites *McBride v. Merrell Down and Parns., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986), as authority for not considering the Reply Brief in the present case. However, *McBride* concerns briefs subject to rules of procedure for cases before the Court of Appeals for the Federal Circuit, not rules governing procedure for cases before the Board.

The Decision, page 17, also cites *In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004) as authority for not considering the Reply Brief in the present case. However, once again, *In re Watts* concerns procedure for cases before the Court of Appeals for the Federal Circuit, not for cases before the Board. Regarding *In re Watts*, the Court of Appeals for the Federal Circuit declined to consider appellant’s new argument when that argument was not raised before the Board.

The Decision, pages 9 and 17, also cites *Borden* as authority for not considering the Reply Brief in the present case, citing the proposition that “The failure to raise all issues and arguments diligently, in a timely fashion, has consequences.” Notwithstanding statements in *Borden* to the contrary, according to the rules governing patent appeals before the Board, it is permissible for a reply brief before the Board to even raise an entirely new issue and to present associated new arguments. See 37 CFR 41.41 (mentioning prohibition against new amendments or evidence presented in reply brief, but failing to mention any restriction on timeliness of arguments presented in reply brief) and 41.43 (explicitly indicating that reply brief is allowed to raise new issue, by stating that “the primary examiner . . . may furnish a supplemental examiner’s answer responding to any new issue raised in the reply brief.”).

Borden, 1475, states “This analysis of the purpose and scope of the principal and reply briefs is consistent with the notes accompanying the Notice of Final Rulemaking published in the

Federal Register in 2004, when the present Rules were promulgated . . . there is no suggestion in the notes that the reply brief provides an opportunity to raise an argument that could have been raised in the principal brief." However, this statement is flatly contrary to the record. See rule making notes in Federal Register, as follows (emphasis added):

Section 41.43 is added to permit the examiner to furnish a supplemental examiner's answer to respond to any new issue raised in the reply brief. This would dispense with the need for the Board to remand the proceeding to the examiner to treat any new issue raised in the reply brief. The MPEP will provide that each supplemental examiner's answer must be approved by a Technology Center Director or designee. A supplemental examiner's answer may not include a new ground of rejection. If a supplemental examiner's answer is furnished by the examiner, the appellant is permitted to file another reply brief under Sec. 41.41 within two months from the date of the supplemental examiner's answer.

The former prohibition against a supplemental examiner's answer in other than a remand situation is removed to permit use of supplemental examiner's answers where the examiner is responding only to new issues raised in the reply brief. As a consequence, the requirements pertaining to appellants when prosecution is reopened under former Rule 193(b)(2) are removed.

. . . **The Office will develop examples to help the examiner determine what would or would not be considered a new issue warranting a supplemental examiner's answer.** An appellant who disagrees with an examiner's decision that a supplemental examiner's answer is permitted under this rule may petition for review of the decision under Rule 181.

Examples of new issues raised in a reply brief include the following:

Example 1: The rejection is under 35 U.S.C. 103 over A in view of B. The brief argues that element 4 of reference B cannot be combined with reference A as it would destroy the function performed by reference A. The reply brief argues that B is nonanalogous art and therefore the two references cannot be combined.

Example 2: Same rejection as in Example 1. **The brief argues only that the pump means of claim 1 is not taught in the applied prior art. The reply brief argues that the particular retaining means of claim 1 is not taught in the applied prior art**

69 Fed. Reg. at 49964 (Aug. 12, 2004)

It would be possible to argue that a particular retaining means is not taught just as early as arguing that a pump means is not taught. Since it is permissible for a Reply Brief before the Board to even raise an entirely new issue and present associated arguments, it is all the more permissible for such a Reply Brief to merely present an argument in response to an issue raised by Examiner's Answer. The Reply Brief should, therefore, be considered immediately or after remand for additional briefing.

Issue 3: Does the Reply Brief make an admission regarding whether an argument could have been presented earlier?

The Decision states on page 16 that Appellants “admit” that the Appeal Brief may be subject to the interpretation that its arguments attack the references separately, seemingly suggesting that this is a formal admission, i.e., an admission that Appellants made arguments attacking the references separately in the Appeal Brief, which thereby serves as a waiver of any right to advance other arguments in the Reply Brief. Appellant is aware of no authority for this proposition, and the Decision cites none.

As the Reply Brief states, on page 1, “Appellant’s argument is, in part, that Wical does not teach or suggest first, second, etc. of tiers of objects that are compatible with tabs such as those taught or suggested by Suzuki.” And, on page 3, “It is Appellant’s argument that neither Wical, nor Wical in combination with Suzuki, teaches or suggests ‘in response to a selecting of a tab of the third tier, displaying a page from the electronic catalog database,’ as recited in claim 1.” The Reply Brief does not make an admission regarding whether an argument could have been presented earlier.

Appellant’s statement in the Reply Brief cited in the Decision was merely a polite, conciliatory gesture, which fails by a wide margin to rise to the level of an admission, particularly given that Appellant had no notice admissibility was even an issue, i.e., that a new standard was to be applied governing admissibility of arguments, and given the overall context of Appellant’s remarks in the Reply Brief.

CONCLUSION AND REQUEST FOR ACTION

Upon reviewing Examiner’s Answer, Appellant chose to devote additional time and expense to prepare a Reply Brief responding to an issue raised by Examiner’s Answer, as was proper and within Appellant’s rights. It is not untimely to present an argument in a Reply Brief addressing an issue first raised by the Examiner in Examiner’s Answer.

In a Reply Brief before the Board, it is permissible to present an argument that could have been presented earlier, since it is even permissible for such a Reply Brief to raise an entirely new issue.

Appellant's arguments in the Reply Brief should be considered. It is unfair to deny consideration of Appellant's arguments by subjecting Appellant to a unilateral rule change that now bars certain arguments. The Examiner either concluded that the Reply Brief raised no new issue, or else chose not to respond, regardless.

Alternatively, if the Board, on re-consideration, continues to maintain that Appellant's Reply Brief presented an untimely argument, and if the Board considers that the Examiner should be given another chance to respond, one proper remedy is to remand the case to the Examiner. This is as explicitly stated in the rules and rule making notes.

Further, if the Board continues to maintain that Appellant's Reply Brief presented an untimely argument, Appellant submits that it is not proper to construe a conciliatory statement by Appellant as an admission that effectively waives those arguments. Appellant's polite statement in the Reply Brief fails by a wide margin to rise to the level of an admission, particularly given the rest of Appellant's remarks therein. This is all the more certain when it is considered that Appellant had no notice a new standard would be applied governing admissibility of Appellant's arguments.

Respectfully submitted,

Date: August 30, 2010

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Attachment: Exhibit AA: Reply Brief

EXHIBIT "AA"

In the United States Patent and Trademark Office

In re the application of:)		
Paul-David Morrison)		
)	Group Art Unit:	2174
Filed: 12-15-2000)		
)	Examiner:	Thanh T. Vu
For: Method and apparatus for)		
an interactive catalog)		
)		
Appl. No.: 09/738,050)		
)		
Appellant's Docket:)		
Silikon)		

REPLY BRIEF

Dear Sir:

This Reply Brief is responsive to Examiner's Answer dated January 8, 2008.

Claims 1, 2, 5, 6, 8, 10, 11, 13, 16, 18, 19, 20, 21, 22, 23

Item 1.

Examiner's Answer of January 8, 2008, page 14, asserts that Supplemental Appeal Brief of October 15, 2008, attacked the references separately with regard to claim 1. Appellant regrets that the language of the Supplemental Appeal Brief may be subject to this interpretation. To clarify, in stating that Wical does not teach "a first tier of tabs, each tab in the first tier of tabs representing a first collection of data objects corresponding thereto," [Supplemental Appeal Brief, page 18] and that Wical does not teach "in response to a selecting of a tab of the first tier to produce a selected first tier tab, presenting a second tier of tabs, each tab in the second tier of tabs representing a second collection of data objects, each data object in the second tier also belonging to the first collection of data objects corresponding to the selected first tier tab," [Supplemental Appeal Brief, page 19], etc., Appellant does not intend to simply attack Wical's

failure to teach tabs. Appellant acknowledges that the rejection relies upon combining Suzuki's teaching about tabs with teachings of Wical.

It was not Appellant's intention to argue simply that Wical's failure to teach tabs overcomes the rejection. Appellant's argument is, in part, that Wical does not teach or suggest first, second, etc. of tiers of objects that are compatible with tabs such as those taught or suggested by Suzuki. All the more certainly, neither Wical, nor Wical and Suzuki combined, teach or suggest tiers of objects, where the tiers of objects are compatible with tabs such as those taught by Suzuki, and where the tiers of objects are structurally and functionally related in the manner recited in the claim.

A prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. MPEP Section 2141.03 (citing *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. MPEP 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

It is Appellant's argument that neither Wical, nor Wical in combination with Suzuki, teaches or suggests what is recited in claim 1. In one respect, this is because in view of *all* the teachings of Wical and Suzuki it is clear that combining the teachings relied upon by the Present Office Action from Suzuki with the teachings relied upon by the Present Office Action from Wical, the principle of operation taught by Suzuki would have to be dramatically changed and in a manner that is not workable.

The rejection analogizes "menu options" in Wical to "graphical tabs" of Suzuki. Final Office Action, pages 2-3 (referring to Fig's 2a-2c of Wical and "menu options" such as "hard science and technology"); Examiner's Answer, page 4 ("Suzuki teaches . . . menu options . . . as graphical tabs. . ."). Appellant takes this to mean the rejection analogizes boxes 210 displaying category names in Fig's 2a-2c of Wical [e.g., Wical, col. 10, lines 24-29] to the tabs shown in Fig. 4 of Suzuki and discussed in Appellant's Supplemental Appeal Brief, pages 14-17. Final Office Action, page 3, referring to Fig. 4 of Suzuki. And Appellant takes it to mean the rejection analogizes the hierarchy of various category levels in Wical [e.g., Wical, col. 10, lines 34-36] to the "hierarchical menu options . . . displayed as graphical tabs" of Suzuki.

With regard to Fig. 4, Suzuki states that “Style-of-rendition icon windows are provided in a lower portion of the displayed screen, and a musical score corresponding to the original music-piece note data (white data) MD is shown in an upper portion of the displayed screen. Further, as display areas for showing style-of-rendition icons, first and second layers L1 and L2 are provided immediately above the musical score display area and a third layer L3 is provided immediately below the musical score display area. Thus, the display mode of FIG. 4 is called a “three-layer pasting” display mode.” Suzuki, col. 8, lines 47-57.

Appellant submits that the boxes 210 displaying category names, as described by Wical for Fig’s 2a-2c, are not suited to modification for use as tabs according to the tabs of the “three-layer pasting display mode,” as described and illustrated by Suzuki.

The functioning of and purpose for tabs taught by Suzuki are different than claim 1 of the present invention. Firstly, according to the arrangement described by Suzuki regarding Fig. 4, the selection of a tab from one tier in the bottom portion of the displayed screen affects one part of the top portion of the displayed screen, whereas the selection of a tab from a different tier in the bottom portion of the displayed screen affects a different part of the top portion of the displayed screen.¹ In contrast, claim 1 of the present invention, which recites “. . . in response to a selecting of a tab of the first tier . . . presenting a second tier of tabs . . . in response to a selecting of a tab of the second tier . . . presenting a third tier of tabs . . . in response to a selecting of a tab of the third tier, displaying a page from the electronic catalog database . . .”

Secondly, and perhaps even more importantly, the rejection analogizes allegedly “*hierarchical* menu options . . . displayed as graphical tabs” in Fig. 4 of Suzuki to boxes 210 displaying category names, as described by Wical for Fig’s 2a-2c. The rejection relates the tabs of Suzuki to “*hierarchical*” menu options because claim 1 recites tabs that have a hierarchical,

¹ For example, “In the case where saxophone (“Sax”) has been selected as shown in FIG. 4 . . . the user first clicks on the “attack” (“Attack”) state and then clicks on the “bend-up” (“BndUp”) style of rendition. . . . Then, as the user manipulates the mouse to drag and drop the leftmost “deep and slow” bend-up-candidate icon B11 at the location of the leading note (G4) in the first measure of the musical score data, a “deep and slow” bend-up icon B1d is pasted to a location of the second layer L2 corresponding to the leading note (G4) of the first measure as shown in FIG. 4.” Suzuki, col. 9, lines 48-62.

tiered relation to one another. However, the table in Fig. 12 of Suzuki shows that at least the first two rows of tabs in Fig. 4 are not related in this manner. That is, table indicates the first row of tabs in Fig. 4 is for selecting a column in the table, and the second row of tabs in Fig. 4 is for selecting a row in the table. Thus, the second row of tabs taught by Suzuki Fig. 4 is not a hierarchy below that of the first row of tabs. The second row of tabs does not belong to a tab of the first row.

Consequently, the tabs of Suzuki are not compatible with the Examiner's alleged teaching of Wical, "in response to a selecting of an menu option of the first tier . . . , presenting a second tier . . . , each data object in the second tier also belonging to the first . . . data objects corresponding to the selected first tier menu option" [Examiner's Answer, page 3], and are not compatible with claim 1, which recites "in response to a selecting of a tab of the first tier . . . , presenting a second tier of tabs . . . , each data object in the second tier also belonging to the first . . . data objects corresponding to the selected first tier tab." That is, claim 1 recites a hierarchical relation between tier one and tier two tabs. The tabs of Suzuki cannot be substituted into the teaching of Wical to produce the structure and function recited in claim 1.

For at least these reasons, Appellant submits that the combination of Wical and Suzuki is improper.

Item 2.

Likewise, Appellant argued that Wical does not teach "in response to a selecting of a tab of the third tier, displaying a page from the electronic catalog database," as recited in claim 1. Appellant wishes to reiterate, clarify and expand.

Once again, it was not Appellant's intention to argue simply that Wical's failure to teach tabs overcomes the rejection. Appellant acknowledges, once again, that the rejection relies upon combining Suzuki's teaching about tabs with teachings of Wical. Appellant's argument is that the rejection relies upon Wical, Fig. 2c, which the examiner asserts shows "a page from electronic catalog database displayed in 310 when a[n] option is selected," to meet the recited claim limitation "displaying a page from the electronic catalog database." Final Office Action of June 21, 2007, page 3; see also, Examiner's Answer, page 4. However, Wical does not teach this claim limitation. To establish *prima facie* obviousness of a claimed invention, all the

limitations of the subject claims must be taught or suggested by the art relied upon. MPEP 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

From the claim itself, it may be entirely clear that the term “page” refers to a electronic version of page, i.e., like a “page” from a paper catalog, which is an ordinary meaning. However, as referred to in the specification, the term “page” has two different meanings that depend upon the context. Consideration should also be given to the specification. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996).

The specification meanings of the term “page” are evident in the following passage:

Referring now to FIG. 9, which is a screen of a catalog browser and an electronic bookcase embodiment of the current invention, the catalog viewing page 400 is displayed as in FIG 1

...
Once a catalog is accessed, it is preferably displayed in the viewing window 400 in a manner such as described by FIG. 1. The catalogs are preferably formatted in a manner that permits the display of the multiple tiers of tabs as described in FIGs. 1-8. . . . The tabs or buttons 401-406 permit each displayed catalog to be manipulated, such as accessing the previous catalog page 401, accessing the next catalog page 402, . . . Thus the libraries permit the organization and access of current catalogs for professionals including purchasing agents, engineers, scientists, and architects who require occasional or frequent access to a variety of catalogs.

Current application, page 44, line 11 - page 45, line 15.

From the above passage it should be understood that in claim 1, “displaying a page from the electronic catalog database” refers to a catalog page, such as “catalog page 401,” and not a “catalog viewing page” of a user interface (e.g., browser), such as “viewing window 400.” That is, it would *not* make sense to state “displaying a catalog viewing page from the . . . catalog . . .” On the other hand, it *does* make sense to state “displaying a catalog page from the . . . catalog . . .”

The Final Office Action, page 3, argues that in Wical Fig. 2c, a “page from [an] electronic catalog database is displayed in 310 when a tab is selected.” See also Examiner’s Answer, page 4. However, in the teaching relied upon for the rejection, Wical does not teach or suggest that there is “displayed in 310” a “page from the electronic catalog database, “as the term “page” is used in claim 1 of the present application.

Regarding example displays Figs. 2a-2e, Wical states that they “illustrate navigating with the categories generated from the topic table 165,” [Wical, col. 10, lines 12-13] which includes a “hierarchy of topics . . . based on themes extracted from the documents 100” [Wical, col. 6, lines

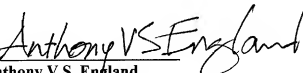
60-63]. Describing Fig. 2c, Wical states "In response, the virtual bookshelf system displays the first page of the hierarchical structure for the parent node of 'hard science and technology.' The hierarchical structure is displayed in a navigation section 310 and a history section 300. " Wical, col. 12, lines 14-18.

From the above context from Wical, it should be appreciated that Wical's navigation section 310 that is relied upon for the rejection is a viewing page of a user interface, not a page from the electronic catalog database, "as the term "page" is used in claim 1 of the present application. Consequently, the teaching relied upon for the rejection does not meet the recited claim limitation "displaying a page from the electronic catalog database."

REQUEST FOR ACTION

Based on the above arguments and Appellant's previously filed Appeal Brief, Appellant requests that all pending claims of the present application be allowed and the application promptly be passed to issuance.

Respectfully submitted,

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